

REMARKS

I INTRODUCTION

Claims 30-36, 38-45, 47-54, 57-64 and 67-107 are pending and stand rejected. The following is Applicant's response to the rejections made in the Office Action (presented in the same order as addressed in the Office Action).¹

II THE OBVIOUSNESS REJECTIONS SHOULD BE WITHDRAWN

A. CLAIMS 30-33, 36, 39-45, 47, 49, 51, 54, 57-64, 67, 79-85, 87-90, 92 AND 100 ARE NOT OBVIOUS IN LIGHT OF THE PRIOR ART

Claims 30-33, 36, 39-45, 47, 49, 51, 54, 57-64, 67, 79-85, 87-90, 92 and 100 stand rejected under 35 U.S.C. §103(a) as allegedly unpatentable over "Services: AT&T provides compass" (hereinafter AT&T) in view of U.S. Patent No. 4,992,940 to Dworkin ("Dworkin"). For at least the reasons that follow, Applicant requests reconsideration and withdrawal of this rejection.

In order for a claim to be rejected for obviousness under 35 U.S.C. § 103(a), not only must the prior art teach or suggest each element of the claim, the prior art must also suggest combining the elements in the manner contemplated by the claim. See *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F. 2d 931, 934 (Fed. Cir. 1990); *In re Bond*, 910 F. 2d 831, 834 (Fed. Cir. 1990). The Examiner bears the initial burden of establishing a prima facie case of obviousness. M.P.E.P. §2142. To establish a prima facie case of obviousness, the Examiner must show that three basic criteria are met. M.P.E.P. §2143. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the references' teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference or references, when so modified or combined, must teach or suggest all of the claim limitations. *Id.* Further, the teaching or suggestion to make the claimed combination and the reasonable expectation of

¹ The Examiner is reminded of the co-pending application no. 09/504,374 by the same inventor of the instant application.

success must both be found in the prior art, and not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). Finally, in discharging the initial burden of establishing a *prima facie* case, the Examiner must make particular findings as to establish the motivational element. *In re Kotzab*, 217 F.3d 1365 (Fed. Cir. 2000). That is, the PTO cannot rely on mere conclusory statements but instead must explain its reasoning why one of ordinary skill would be motivated to select the references and combine them to reach the claimed invention, and must provide evidence to support such a motivation. *In re Lee*, 277 F.3d 1338 (Fed. Cir. 2002).

Applicant respectfully submits that none of these criteria for obviousness are met here.

The Office Action fails to explain why one of ordinary skill would be motivated to select the two cited references and combine them to reach the claimed invention of Applicant. The Examiner fails to cite specific portions of the references which themselves suggest that the references should be combined in the manner claimed, nor does he offer any support for such elsewhere. Thus, the Examiner has failed to present a *prima facie* case of unpatentability under section 103.

Indeed, the AT&T and Dworkin references cannot properly be combined for at least the reason that modifying AT&T in view of Dworkin changes the principle of operation of AT&T, rendering it unsuited for its intended purpose. AT&T was merely a directory of directories for Internet users, not by customers such as Dworkin. In AT&T the system was used for scientific research. In contrast, Dworkin discloses a menu-driven computerized system used by a customer for the purpose of commerce. The internet was a system of multiple servers each a research facility providing scientific research information, whereas in Dworkin there existed only a single server or central computer for providing product information. Combining would therefore change AT&T's principle of operation from a system of multiple central computers to one of a single central computer and its use from providing scientific research information to one providing product information. One system (AT&T) was for providing scientific research information and the other (Dworkin) about providing product information. It is improper to combine such disparate references.

Further, the AT&T reference only states that the directory of directories provides information so the user 'know(s) where to look to find out where the info is located'. Neither it

nor Dworkin ‘provide to said customer at said computerized remote facility a list of computerized central communications facilities permitting said customer to select and contact at least one other computerized central communications facility to request additional information relating to said goods or services’ as is herein claimed. Therefore, the prior art references, even when so modified or combined, do not teach or suggest all of the claimed limitations.

For at least these reasons, Applicant respectfully submits that the AT&T and Dworkin references cannot properly be combined.

Accordingly, and since the Examiner has not provided an explanation (supported by evidence) of a motivation to combine the AT&T and Dworkin references in light of the conflicting requirements of these references, Applicant requests reconsideration and withdrawal of all rejections based on combining AT&T and Dworkin.

B. CLAIM 32 IS NOT OBVIOUS IN LIGHT OF THE PRIOR ART

Claim 32 stands rejected under 35 U.S.C. §103(a) as allegedly unpatentable over AT&T in view of Dworkin. However, Applicant respectfully submits that none of the criteria for obviousness are met here. For at least the reasons that follow, Applicant requests reconsideration and withdrawal of this rejection.

First, as discussed fully above, it is improper to combine the AT&T and Dworkin references. For at least this reason alone, the rejection under 35 U.S.C. §103(a) should be withdrawn.

Furthermore, the cited art fails to meet at least one element in each of the rejected claims. dependent claim 32 recites, *inter alia*, The

apparatus of claim 30, wherein at least one of said computerized central communications facilities is further programmed to contact the customer and apprise said customer of goods or services offered or any special offerings.

In pertinent part, thus, as recited above the dependent claim recites a central facility ‘programmed to contact the customer’. Neither AT&T nor Dworkin disclose, teach or suggest this feature, whether considered alone or in combination. Even if Dworkin as at the cited

passage (col. 9, lines 36-47) teaches apprising the customer of special offerings, he does not teach that the central facility contacts the customer.

For at least these reasons, Applicant submits that the references, even if combined, do not disclose, teach nor suggest at least the limitations of dependent claim 32 as set forth above. Accordingly, Applicant respectfully requests reconsideration and withdrawal of this rejection.

C. CLAIM 53 IS NOT OBVIOUS OVER THE PRIOR ART

Claim 53 stands rejected under 35 U.S.C. §103(a) as allegedly unpatentable over AT&T and Dworkin in view of U.S. Patent No. 5,347,632 to Filepp (“Filepp”). However, Applicant respectfully submits that none of the criteria for obviousness are met here.

As an initial matter, the Office Action fails to explain why one of ordinary skill would be motivated to select the three cited references and combine them to reach the claimed invention of Applicant. Thus, the Examiner has failed to present a *prima facie* case of unpatentability under section 103.

Furthermore, for the reasons discussed more fully above, the combination of AT&T and Dworkin is improper. Similarly, the combination of Filepp with AT&T is improper as in Filepp the customer is only permitted a single source of information whereas in AT&T the user has multiple sources. Filepp therefore teaches away from AT&T and it is as such not proper to combine.

Also, nowhere in the cited passage does Filepp teach providing auction services. He only provides for the ‘display of quotes and buy/sell orders for stocks and bonds’.

Accordingly, reconsideration and withdrawal of this rejection is respectfully requested.

III. THE DOUBLE PATENTING REJECTION SHOULD BE WITHDRAWN

Claims 30-36, 38-45, 47-54, 57-64 and 67-107 stand rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-5 of U.S. Patent No. 6,055,514 in view of AT&T and Dworkin.

As an initial matter, the Office Action fails to explain why one of ordinary skill would be motivated to select AT&T and Dworkin and combine them with the '514 patent to reach the claimed invention of Applicant. However, even this would not establish a *prima facie* case of obviousness-type double patenting. Rather, in order to establish grounds for a double patenting rejection, the Office must analyze all of the considerations relating to alleged obviousness under section 103. MPEP §804. This was not done.

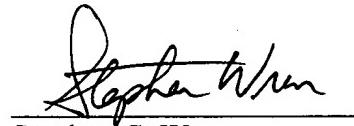
Furthermore, with respect to the double patenting rejection the Office Action fails to present any discussion at all for any of the claims other than claim 30.

Accordingly, this rejection should be reconsidered and withdrawn.

CONCLUSION

It is therefore respectfully submitted that claims 30-36, 38-45, 47-54, 57-64 and 67-107 are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,



Stephen C. Wren
Inventor
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